

PATENT
THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Docket: PST 6366 P1US/2187
Martin HELLSTEN et al.	:	
	:	Group Art Unit: 1796
Serial No.: 10/520,491	:	
	:	Examiner: Daniel S. Metzmaier
Int'l Application No.: PCT/SE2003/001015	:	
Int'l Filing Date: June 17, 2003	:	Confirmation Number: 9838
	:	
For: A DRAG-REDUCING AGENT FOR USE	:	
IN INJECTION WATER AT OIL RECOVERY	:	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition Under 37 CFR § 1.181

Sir:

This Petition is filed in response to the Advisory Action mailed July 21, 2010 in the above case. In said Advisory Action the examiner refused to enter the claim amendments made in the Amendment filed on July 7, 2010. Applicants disagree with the examiner's refusal to enter and respectfully request that, pursuant to MPEP 1002.02(c) 3(h), the Technology Center Director review and reverse the examiner's decision.

Initially, in the Advisory Action mailed 7/21/10 the examiner alleges the proposed claim amendments raise new issues and/or would require a search. MPEP 714.13 III provides some guidance on refusal to enter amendments.

"The refusal to enter the proposed amendment should not be arbitrary.... If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for non-entry should be concise... . Examiners should indicate the status of each claim of record or proposed in the amendment, and which of the proposed claims would be entered if filed in a separate paper... . Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for

appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments.”

(Emphasis ours.)

Applicant’s respectfully submit that the examiner failed:

1. to provide an explanation as to why the proposed amendment raises new issues that would require further consideration and/or search.
2. to indicate the status of each claim of record or proposed in the amendment, and which of the proposed claims would be entered if filed in a separate paper.
3. to notify applicants if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments

In the continuation sheet for the Advisory, the examiner cites the grounds in support of his refusal to enter Applicant’s Amendment. Applicants will address each of those grounds below.

(1) The amendment is non-compliant.

Applicants have corrected the claim status identifiers and submitted the corrected response on August 23, 2010. A copy of that response is attached hereto as Exhibit 1.

(2) Claim 8 presents two concentration limitations sequentially that appear inconsistent and indefinite. Attention may be further directed to 37 CFR 1.75 (i) regarding claim form.

Applicants respectfully submit that there is nothing inconsistent or indefinite in the amendments to claim 8. The limitations of claims 17 and 18 were combined into claim 8, the relevant portions of which read as follows:

“... wherein the weights of components a), b) and c) are 20-95% by weight, 10-70% by weight and 1-50% by weight, respectively, based on the total amount of a), b) and c), which is from 50-400 ppm and said water in the absence of said drag reducing agent has an electrolyte content of 0.01-7% by weight.”

Thus, the composition comprises 20-95% of component a), 10-70% component b) and 1-50% component c), wherein the total amount of a), b) and c) of the drag reducing agent in the injection water is 50-400 ppm, and the electrolyte content of said water, in the absence of said drag reducing agent is 0.01-7% by weight.

In Applicant's opinion, the claim language is clear to the skilled person and this should not have been a basis for not entering the Amendment in question.

(3) The limitations of claim 8 have not hereinbefore been presented in amended form, filed on 7/7/2010.

Applicants are not entirely sure what the examiner means here in that the limitations of claim 8 were taken from claims 17 and 18 (both dependent on claim 8). Additionally, these amendments were made, in part, based on the examiner's comments contained in the third full paragraph of then Office Action mailed January 8, 2010, which is repeated herein for the convenience of the Commissioner.

"Claim 8 does not require component (b), i.e., (b) = 0 (zero) % (w/w) or alternatively put, (b) is optional. Specific attention is directed to claim 17 dependent on claim 8 and includes the limitation that (b) is 0-70% by weight."

Additionally, claims 17 and 18 were on the record, were searched and were examined. Thus, incorporating the limitations of these claims into claim 8 could not reasonably be viewed as raising new issues, and the examiner has provided no reasons to the contrary. In view of the above, Applicants respectfully submit that this is not a legitimate basis for the examiner to refuse entry of Applicant's Amendment.

(4) Applicants do not provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. Applicants combine the limitations of claims 17 and 18 to address the issue of the claimed component (b) concentration reading on zero (0)% and Appellants assert that the amendment addresses the examiner's point at page 6 of the Final Office Action, mailed 1/8/2010. Appellant's reference to page 6 of the Final Office Action, mailed 1/8/2010. This issue was initially raised at page 3 of the Office Action mailed 2/28/2008. Applicants could have but chose not to amend claim 8 prior to

the close of prosecution in the Final Office Action, mailed 1/8/2010, such as, at the time similar amendments were made to claim 11 (response filed 9/10/2009). It is concluded that the amendment does not provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.”

It appears to Applicants that this is the main reason why the examiner has refused to enter Applicant's Amendment. More particularly, the examiner is alleging that Applicants *have failed to provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented*. Applicants disagree and in fact submit that the examiner's basis for refusal are improper for the following reasons.

Initially, The Director is respectfully requested to note that Applicants filed a Request for Continued Examination in this case on April 13, 2009. The filing date of the RCE is subsequent to the Office Action of 2/28/08, which is relied on by the examiner in support of his position that applicants could have made the amendments earlier.

First, Applicants respectfully submit that it is improper, and in fact prejudicial to Applicants for the examiner to rely on office actions more than two years old, which were issued prior to the filing date of Applicant's RCE.

Further, in the Office Action of 2/28/08 the examiner comments made regarding component (b) were made under the heading of Claim Interpretation, and it does not appear that they were made with respect to any specific art rejection.

Finally, prosecution in this case, as with every case, evolves. Subsequent to the RCE the examiner issued an intervening non-final Office Action (mailed 6/24/10) and the issue in point 2) above regarding component b) was NOT raised. In fact, subsequent to the RCE, it was raised for the first time in the final Office Action of 1/8/2010. Thus, applicants respectfully submit that the amendments were made in large part in response to the comments of the examiner in the final action of 1/8/2010, which were made in response to Applicants previously submitted Amendment. All of this was done subsequent to the filing of the RCE. Rather than working with Applicants in trying to identify allowable subject matter, the examiner opted to search the

entire record, even pre-RCE, for some resemblance of support for his position that the amendment should have been earlier presented. Not only is this unfortunate, Applicants respectfully submit that to an impartial reviewer, it seems that the examiner was more interested in trying to justify not entering Applicants Amendment than in trying to work with Applicants in trying to identify allowable subject matter. In any case, Applicants respectfully submit that the examiner has failed to meet his burden in refusing to enter Applicants Amendment.

In view of the foregoing remarks the Director is respectfully requested to reverse the examiner's decision and enter the subject Amendment filed on July 7, 2010 (corrected version filed on August 23, 2010, copy attached).

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Ralph J. Mancini", enclosed within a large, loopy oval shape.

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